

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(s): Lonka et al.

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Commissioner of Patents

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APPEAL BRIEF

Sir:

This is an appeal in regard to the final rejection of claims 2-7, 13 and 15-19 in the above-identified patent application. Claims 8-12 were found allowable but objected to as being dependent upon a rejected base claim. Claims 2-7, 13 and 15-19 are listed in Appendix I. Claims 8-12 are listed in Appendix II. A Notice of Appeal was mailed to the USPTO on November 26, 2001. This brief is being filed in triplicate as required by 37 C.F.R. 1.192. The fee under 37 C.F.R. 1.17(f) is enclosed. Please charge deposit account 16-1350 for any fee deficiency.

It is respectfully submitted that there was an error in the Office Action "Summary" mailed with the final rejection of June 18, 2001. The "Summary" refers to claim 1 as still pending in the application. Claim 1 was cancelled in Applicants' first Amendment filed on March 30, 2001. Also, there is no mention in

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as

the "Summary" of the fact that claim 13 was rejected. In the claim rejections themselves, where is the reasoning for the rejection of claim 15? The rejection of claim 15 under 35 U.S.C. 112 was attended to in Applicants' response to the final rejection.

#### I. Real Party In Interest

The real party in interest is Nokia Mobile Phones Limited.

#### II. Related Appeals and Interferences

There are no directly related appeals or interferences regarding this Application.

#### III. Status of Claims

Claims 2-13 and 15-19 are pending in this Application. Pending claims 2-7 and 15-49 have been finally rejected by the Examiner. Claims 8-12 were found allowable but objected to. Attached to this Brief is Appendix I (the rejected claims) and Appendix II (the allowable claims). The rejection of claims 2-13 and 15-19 is being appealed.

#### IV. Status of the Amendments

Since the final rejection of June 18, 2001 and the Amendment of September 17, 2001, no further amendments have been filed in this application.

#### V. Summary of the Invention

The present invention relates to the structure of a telescopically expanding telephone, and to the location of its various elements. The object of the present invention is to introduce a telephone which is small in the transport position, but is still provided with a larger-size user interface. Another object of the present invention is to have a telephone that is easy to use, durable and ergonomic. Still another object of the invention is that in the regular usage position, the telephone antenna does not fall in the shadow of the user's hand.

The various objects of the present invention are achieved by locating, in the upper part of the telephone, an antenna and the radio frequency parts, among others; and in the lower part, the power source and the major part of the keys, among others. The lower part and the upper part are movably attached to each other, so that the telephone has a small-size transport position and a larger-size operating position.

The telephone according to the clearly defined claimed features of the present invention comprises a first part and a second part attached thereto, the second part being movable in relation to the first part between a first position and a second position. The invention is characterized in that the first part comprises a radio transmitter/receiver and a connected antenna, and the second part comprise an arrangement for fastening a battery to the second part.

According to a preferred embodiment of the present invention, the upper part of the telephone according to the invention comprises at least an antenna, a radio transmitter/receiver, a loudspeaker, a microphone and a display as well as part of the

keys and a scanner for a smart card. The lower part comprises an arrangement for fastening a battery or a corresponding power source for the telephone, as well as the major part of the keys. The lower part of the telephone is designed in such a manner so that during operations, it is natural for the user to hold the lower part of the telephone in the users hand. Thus, the antenna provided in the upper part is not left in the shadow of the user's hand, and not even in close proximity to the users hand. The battery attached to the lower part is a fairly heavy component, which improves the ergonomic properties of the telephone according to the invention in comparison with, for example, the telephone according to Figure 3, where the lower part is very light. By installing the telephone components in the upper and the lower parts in an advantageous fashion the number of electric contacts in between the parts is kept small, which is advantageous for usage security. In particular, the features of the present invention enables the use of a relatively large display and keyboard even in a small mobile phone.

#### VI. Issues

1. Are claims 3, 4, 13, 16-19 unpatentable under 35 U.S.C. 103(a) over Tsugane et al. (U.S. Patent No. 5,657,370) in view of Holshouser et al. (U.S. Patent No. 6,151,486)?
2. Is claim 2 unpatentable under 35 U.S.C. 103(a) over Tsugane et al. (U.S. Patent No. 5,657,370) and Holshouser et al. (U.S. Patent No. 6,151,486), and further in view of the Applicant's admitted prior art (Fig. 4)?

3. Is claim 5 unpatentable under 35 U.S.C. 103(a) over Tsugane et al. (U.S. Patent No. 5,657,370) in view of Holshouser et al. (U.S. Patent No. 6,151,486), and further in view of Bremer (U.S. Patent No. 6,018,671)?

4. Are claims 6, 7 and 18 unpatentable under 35 U.S.C. 103(a) over Rudisill et al. (U.S. Patent No. 6,208,874) in view of Holshouser et al. (U.S. Patent No. 6,151,486)?

#### VII. Grouping of Claims

The claims do not stand or fall together. There are four (4) groups of claims. The groups are as follows:

Group 1-Claims 3, 4, 13 and 16-19

Group 2-Claim 2

Group 3-Claim 5

Group 4-Claims 6 and 7

In accordance with 37 C.F.R. 1.192(c)(7), an explanation of why the claims of the groups are believed to be separately patentable is contained in the argument section below.

#### VIII. Argument

##### A. Claims 3, 4, 13 and 16-19

Claim 18 calls for a telephone comprising:

(1) a first part;

(2) a second part attached to the first part movable between a first position and a second position;

(3) a radio transceiver in the first part and an antenna coupled thereto;

(4) and in the second part, a keyboard for providing control input information to the radio transceiver, and

(5) an arrangement for attaching a battery to the second part parallel to the keyboard and additionally comprising in the second part a grip design for allowing a user to hold the telephone by the second part.

Primary objects of the combined features of the present invention include introducing a telephone which is small in the transport position, but is still provided with a large-size user interface. Also, a telephone that is, with respect to its mechanical structure, easy to use, durable and ergonomic. Yet another object of the present invention is that in the regular usage position, the telephone antenna does not fall in the shadow of the user's hand. The combination of these objections are what motivated applicant to develop the invention described in this application. These objects are achieved by locating, in the upper part of the telephone, an antenna and the radio frequency parts, among others, and in the lower part of the telephone, the power source and the major part of the keys, among others, all in a specific arrangement. The lower part and the upper part are movably attached to each other, so that the telephone has a small-size transport position and a larger-size operating position.

On the other hand, Tsugane et al. developed a cellular portable radiotelephone and was primarily motivated to produce a radiotelephone that was excellent in operability and free from a cumbersome operation, and the possibility of an erroneous operation or damage. Tsugane's telephone included a first housing having at least a telephone receiving section, and a second housing slidably and pivotally mounted to the first housing and capable of being housed in the first housing, the second housing having a front surface, a rear surface serving as a slide surface to slide on the first housing, and a key operating section, wherein a display is disposed on the first or second housing, and a telephone transmitting section is disposed on the second housing.

A very good example of how the Examiner "stretched" the teachings of the Tsugane et al. patent so as to be able to conclude obviousness is where the Examiner cites Item 22 in Tsugane's Fig. 1 as anticipating appellant's claimed "grip design" feature. Item 22 in Tsugane's Fig. 1 is defined as a "lower housing" in the specification. Applicant fails to find any references whatsoever to the concept of grip designs in the Tsugane et al. disclosure. In fact, one skilled in the art would also fail to note any teaching or suggestion of a grip design in the lower housing. Apparently, the Examiner interprets the group of parallel lines on one side surface of the lower housing illustrated in Tsugane's Fig. 1 as a grip design. However, in the absence of an actual teaching or suggestion of a grip design, a person skilled in the art could very well interpret these lines as just the draftsman's view of the optimum way of representing a side surface in a drawing. Nothing else! Doesn't it seem "obvious" that a little hindsight derived from applicant's described invention may have been used

by the Examiner when the Examiner stated, as support for the rejection under 35 U.S.C. 103(a) over Tsugane that "...and a grip design for allowing a user to hold the telephone by the second part (Fig. 1, Item 22)."

Taking the actual teaching of the Tsugane et al. patent a step further one skilled in the art should have no difficulty noting that there is the complete absence of any disclosure or suggestion in the Tsugane et al. patent regarding the location of a radio transceiver within the parts of the illustrated portable telephone. Applicants' claims require that the radio transceiver be located in a different part than the keyboard. Tsugane et al. teach that the upper part of the portable telephone in Fig. 1 comprises a "telephone receiving section 23" while the lower part comprises a "telephone transmitting section 24." However, reference designators 23 and 24 only seem to designate a loudspeaker and a microphone respectively.

Claim 18 is also limited to a telephone including:

"...an arrangement for attaching a battery to the second part parallel to the keyboard and additionally comprising in the second part a grip design for allowing a user to hold the telephone by the second part."

It is noted that the Examiner admitted that the Tsugane et al. reference is silent on the location of a battery in the portable telephone in Fig. 1. On page 3 of the final Official Action the Examiner stated:

"An arrangement for attaching battery is inherently in Tsugane. However, Tsugane does not explicitly show the



arrangement of attaching the battery to the second part parallel to the keyboard."

To correct some of the rather obvious "missing links" in the Tsugane et al. reference the Examiner cites Figs. 6B, 7 and 9 of the Holshouser et al. reference to make up for this deficiency in Tsugane et al. However, it is submitted that Holshouser's Fig. 7 does not show a battery at all. The reference designator 75 cited by the Examiner designates a "bottom housing portion." In his Fig. 6B and 9, Holshouser et al. illustrate a battery (64, 95) schematically as a component of an electrical schematic diagram without giving any hints about its actual appearance or location. Applicant does not debate the fact that a mobile telephone is known to include a battery, but it is respectfully submitted that applicant claims a structure where the battery has a specific location with respect to certain other parts of a mobile telephone. The specific location of the battery is significant and forms part of applicant's invention. Such a specific structure is neither disclosed nor suggested by the schematic diagrams of Holshouser et al.

In addition it is respectfully pointed out that the claims of this application which define the invention specifically refer to "...an arrangement for attaching a battery to the second part..." of the telephone "...parallel to the keyboard..."

Webster's Seventh New Collegiate Dictionary defines the word "parallel" as

"extending in the same direction everywhere equidistant and not meeting ... everywhere equally distant..."

Even if the schematic drawings of Holshouser's Figs. 6B and 9 could be interpreted to disclose something about the location of the battery (which is not the case because the battery is only shown schematically in the drawings without any real reference to its physical location), the most that could be said about the battery would be that it is close to the keypad or next to the keyboard. There is definitely no teaching or suggestion that it is parallel to the keypad. Fig. 7 in Holshouser et al. is completely meaningless with regard to the issue of patentability of the present invention because it does not disclose any battery, let alone its physical location. The Examiner has simply picked the reference designator 75 from Fig. 7 without bothering to check its meaning from the specification. In the specification the reference designator 75 is said to be a "bottom housing portion".

In fact, if one combines the teachings of figs. 6B and 2 in Holshouser et al. with Tsugane et al., one may arrive at an interpretation according to which the battery is located in the same part with the radio frequency parts, the antenna and the keyboard. Such an arrangement is equal to that of applicants' admitted prior art in figs. 7 and 9, i.e. it would teach a person skilled in the art to put the battery and keyboard into different parts of the mobile telephone.

Regarding possible interpretations of the location of a battery in the Tsugane et al. reference, applicant points at Tsugane's fig. 2B as well as figs. 4A-4C and 5, all of which share the feature of the lower (keyboard) part being relatively thin and small compared to the upper part. The battery is the most space-consuming single component in the mobile telephone, which

certainly does not encourage placing it into the clearly smaller one of the movable parts.

Neither Holshouser et al. alone, nor its possible combinations with Tsugane et al. can, by any stretch of the imagination, be said to render appellant's claimed structure obvious, i.e., where the lower part of the device includes a keyboard, a grip design and means for attaching a battery to the lower part parallel with the keyboard, while an upper part of the same device includes the radio frequency parts and the antenna.

It is respectfully submitted that the Examiner's rejection is completely without legal merit because it is based on a rejection where various items in cited prior art are alleged to show something else other than what the actual disclosure of the prior art actually suggests.

From the entire record what is "obvious" is that the only real basis for the Examiner's combination of the Tsugane et al. and Holshouser et al. patents is appellant's own disclosure, i.e. the hindsight obtained from this application. The simple fact of the matter is that by no stretch of the imagination can it be correctly legally concluded that appellant's invention as defined in claims 3, 4, 13 and 16-19 is obvious under 35 U.S.C. 103(a) from the combined teaching of the disclosures of the Tsugane et al. and Holshouser et al. patents.

It is very clear that, only as a result of the hindsight obtained from Applicant's own disclosure could the Examiner have concluded that it would have been obvious to one of ordinary skill in the art to combine the Tsugane et al. and Holshouser et

al. patents, and conclude that such combination render appellant's claimed invention legally "obvious".

The legal standards for a correct rejection under 35 U.S.C. 103(a) are settled in the law. To reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness. See In re Deuel, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214, (Fed. Cir. 1995). In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Obviousness is a question of law. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987) cert. denied, 481 U.S. 1052 (1987). The courts have held that the proper approach to the obviousness issue starts with the claimed invention as a whole. Kimberly-Clark Corp. v. Johnson & Johnson, 745 F.2d 1437, 1448 (Fed. Cir. 1984). The invention as a whole embraces the structure, its properties and the problem it solves. In re Wright, 848 F.2d 1216, 1219 (Fed. Cir. 1988). Section 103 is applicable when there is no single prior art item that completely discloses, i.e., anticipates, the claimed invention. Kalman v. Kimberly-Clark, 713 F.2d 760 (Fed. Cir. 1983).

The proper approach to making a determination of obviousness was described by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1, 17 (1966):

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in

the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. It is respectfully submitted that the Examiner has simply not met the proper legal requirements for a valid rejection under 35 U.S.C. 103(a).

As the CAFC has stated in *In re Rouffet*, 47 USPQ2d 1453 (CAFC, 1998) at pages 1457 and 1458:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references...(Emphasis added)

Neither Tsugane et al. nor Holshouser et al. were confronted with the same problems as applicant. Thus, why would one skilled in the art choose the teachings of Tsugane et al. and Holshouser et al. to solve appellant's objectives and achieve appellant's motivations. In addition, as shown above, even if one combines these two references there is simply no disclosure or suggestion of appellants claimed invention.

The CAFC has many times during the last year affirmed the strict requirements for a valid rejection under 35 USC 103(a).

In Ecolchem Inc. v. Southern California Edison Co., 5 USPQ2d 1065 (CAFC, 2000) it was stated at page 1065;

Although the suggestion to combine prior art references to achieve the invention claimed in the patent may be found in

explicit or implicit teachings in the references themselves; from ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved, there must be evidence that the skilled artisan, confronted with the same problems as inventor and with no knowledge of the claimed invention, would select elements from the cited prior art references for combination in the manner claimed; implicit; generalized finding that a person of ordinary skill in the art faced with same problem as inventor, would have found the claimed combination obvious is insufficient (Emphasis added)

Furthermore, regarding a rejection under 35 U.S.C. 103(a), it is not realistic in deciding an obviousness question under 35 U.S.C. 103 to pick and choose from any one reference only so much of the reference as will support a given position, to the exclusion of other parts of the reference necessary to a full appreciation of what such references fairly suggest to one of ordinary skill in the art; the mere existence in the prior art of individual elements of a patented invention does not, without more, invalidate a patent under 35 U.S.C. 103. There must be some positive evidence that the bringing together of such elements would have been obvious to a person of ordinary skill in the art. It would reduce patent protection almost to a nullity if an infringer could, in light of subsequent disclosure, combine the prior art and piece together portions of earlier patents, while dropping other parts, and thereby invalidate new combination of old elements. Colt Industries Operating Corp. v. Index-Werke KG, Hahn & Tessky (DC DistCol) 205 USPQ 990.

Therefore the Examiner's rejection of claim 18 based upon the combination of Tsugane et al. and Holshouser et al., should be reversed.

Claim 3 is dependent on claim 18 and includes the limitations additionally comprising in the second part a module which comprises:

a circuit board of the number keyboard,

a charging connector to form a connection to an external charging device arranged to charge a battery attached to the second part, and

a connector to form an electric connection between the first and the second part.

For the same reasons as stated above with regard to claim 18, the combination of Tsugane et al. and Holshouser et al. fail to disclose or even remotely suggest the unique features of claim 3. The combination of Tsugane et al. and Holshouser et al. fail to disclose or suggest the combined limitations of the above additional features of a module in the second part of the telephone in combination with the other features of claim 18. Therefore, the Examiner's rejection of claim 3 based upon the combination of Tsugane et al. and Holshouser et al. should be reversed.

Claim 4 is dependent on claim 3 and includes the further limitation:

"wherein said connector for forming the electric connection between the first and the second part is simultaneously a connector for creating an electric connection between the second part and a battery attached thereto."

For the same reason as stated above with regard to claims 18 and 3, the combination of Tsugane et al. and Holshouser et al. fail to disclose or even remotely suggest the unique features of claim 4. The combination of Tsugane et al. and Holshouser et al. fail to disclose or suggest the combined limitations of the above additional features of a connector for forming the electric connection between the first and second part module in the second part of the telephone in combination with the other features of claims 18 and 3. Therefore, the Examiner's rejection of claim 4 based upon the combination of Tsugane et al. and Holshouser et al. should be reversed.

Claim 13 is dependent on claim 18 and includes the further limitation:

"...wherein the second part is rotatably movable with respect to the first part in between the first and the second position for which function the telephone is provided with a hinge in between the first and the second part."

For the same reasons as stated above with regard to claim 18, the combination of Tsugane et al. and Holshouser et al. fail to disclose or even remotely suggest the unique features of claim 13. The combination of Tsugane et al. and Holshouser et al. fail to disclose or suggest the combined limitations of the above additional features of the second part being rotatably movable in combination with the other features of claims 18. Therefore, the Examiner's rejection of claim 13 based upon the combination of Tsugane et al. and Holshouser et al. should be reversed.



Claim 16 is dependent on claim 18 and includes the further limitation:

"additionally comprising means for receiving an incoming call by adjusting said first part from the first position to the second position."

For the same reasons as state above with regard to claim 18, the combination of Tsugane et al. and Holshouser et al. fail to disclose or even remotely suggest the unique features of claim 16. The combination of Tsugane et al. and Holshouser et al. fail to disclose or suggest the combined limitations of the above additional features of a means for receiving an incoming call in combination with the other features of claim 16. Therefore, the Examiner's rejection of claim 16 based upon the combination of Tsugane et al. and Holshouser et al. should be reversed.

Claim 17 is dependent on claim 18 and includes the further limitation that the phone:

"...is a mobile phone of a digital cellular network."

For the same reasons as state above with regard to claim 18, the combination of Tsugane et al. and Holshouser et al. fail to disclose or even remotely suggest the unique features of claim 17. The combination of Tsugane et al. and Holshouser et al. fail to disclose or suggest the combined limitations of the above additional features of a telephone in the form of a mobile phone of a digital cellular network in combination with the other features of claim 17. Therefore, the Examiner's rejection

of claim 17 based upon the combination of Tsugane et al. and Holshouser et al. should be reversed.

Claim 19 is dependent on claim 18 and includes the further limitation:

"...wherein said grip by the user is at the area of the lower part of the telephone."

For the same reasons as state above with regard to claim 18, the combination of Tsugane et al. and Holshouser et al. fail to disclose or even remotely suggest the unique features of claim 19. The combination of Tsugane et al. and Holshouser et al. fail to disclose or suggest the combined limitations of the above additional features of a grip for a the telephone in combination with the other features of claims 19. Therefore, the Examiner's rejection of claim 19 based upon the combination of Tsugane et al. and Holshouser et al. should be reversed.

#### B. Claim 2

Claim 2 is dependent upon claim 18 but includes:

"...additionally comprising in the first part a display and a quick-action keyboard, and in the second part a number keyboard."

The comments above with regard to the Tsugane et al. and Holshouser et al. references as they pertain to claim 18 are herein repeated with regard to the limitations of claim 2. However, in addition it is noted that appellant's Fig. 4 is used in rejecting claim 2 in that it represents admitted prior art.

Fig. 4 illustrates a known telescopic telephone comprising a housing 401 and an upper sliding part 402 including a loudspeaker 403, a display 404 and a small part of the keys 405. The housing 401 includes the rest of the keys 406, a microphone 407 and an antenna 408. For transporting the telephone, the upper sliding part 402 can be by a sliding motion, placed on top of the housing 401, so that the keyboard 406 is covered.

The functional practicality of the device illustrated in Fig. 4 is dubious, because the antenna is easily left inside the user's hand, or very near to the user's hand, in which case it does not work in the best possible way. In order to realize a precise and versatile display in the device of Fig. 4, there is needed a large amount of leads in between the housing and the upper sliding part, which is problematic with respect to the technical applications. Usually the display 404 is provided with a glass plate or other such easily breakable part that requires a solid supporting structure around it; this requirement is difficult to fulfil in the embodiment according to Fig. 4. Moreover, there are shortcomings in the user ergonomics.

With these combined various disadvantages kept in mind for the Fig. 4 device illustrated in Fig. 4, why would one skilled in the art combine Fig. 4 with Tsugane et al. and Holshouser et al. if one wanted to achieve appellant's objectives? The Examiner's rejection of claim 2 based upon the combination of Tsugane et al. and Holshouser et al., and further in view of appellant's admitted prior art (See Fig. 4), should be reversed.

C. Claim 5

Claim 5 is dependent upon claim 3, which in turn is then dependent upon claim 18, and includes the further limitation:

"...additionally comprising in said module a vibrating alarm device attached to the circuit board of the number keyboard."

All of the above comments with regard to the claims 18 and 3 are herein again repeated, but with regard specifically to claim 5. In addition it is submitted that while the Examiner is correct that the Bremer patent discloses a vibrating alarm device (129), the Examiner is wrong (legally) in the conclusion that the teaching or suggestion of the combined references renders appellant's invention defined by claim 5 as "obvious". It is respectfully submitted that this is just another example of the Examiner finding a claimed element in a reference and simply "gluing" parts of the references together with other references and erroneously concluding that the claimed invention is obvious." Therefore, the Examiner's rejection of claim 5 based upon the combination of Tsugane et al., Holshouser et al. and Bremer should be reversed.

D. Claims 6 and 7

Note that claim 18 has been included in the same group with claims 6 and 7. All of these claims have been rejected over Rudisill et al. in view of Holshouser et al.

Claim 18 (an independent claim) states:

"A telephone comprising a first part; a second part attached to the first part movable between a first position and a second position; a radio transceiver in the first part and an antenna coupled thereto; and in the second part, a keyboard for providing control input information to the radio transceiver, and an arrangement for attaching a battery to the second part parallel to the keyboard and additionally comprising in the second part a grip design for allowing a user to hold the telephone by the second part."

Claim 6 is dependent upon claim 18 and includes the further limitation:

"wherein the second part is slidably movable in relation to the first part in between the first and the second position, for which function the second part comprises slide rails and the first part comprises matching counter-rails."

Claim 7 is dependent on claim 6 and includes the further limitation:

"wherein said first part and second part are in the first position located essentially on top of each other."

Appellant reads in the final official action a rejection of claims 6, 7 and 18 over Rudisill et al. (U.S. Patent No. 6,208,874) in view of Holshouser (U.S. Patent No. 6,151,486). The Tsugane et al. patent was not part of this rejection. Yet in supporting this rejection of claims 6, 7 and 18, the Tsugane et al. patent was included. It is respectfully submitted that

the Examiner's supporting argument for this rejection is very confusing. The Examiner has stated:

"Consider claim 18. Rudisill teaches a telephone comprising a first part (fig. 1, item 52), a second part (fig. 1, item 48) attached to the first part movable between a first position and a second position (i.e., slide open and close, fig. 1); an antenna coupled to the first part (fig. 4, items 90, 92, and 94).

In the second part, a keyboard for providing control input information to the radio transceiver (fig. 1, item 30), and additionally having in the second part a grip design for allowing a user to hold the telephone by the second part (fig. 1, item 48).

An arrangement for attaching a battery to the phone is inherently in Tsugane. However, Tsugane does not explicitly show the arrangement of attaching the battery to the second part parallel to the keyboard. (Emphasis added)

Nevertheless, the claimed limitation is a matter of design preference, and it is very well-known in the art as evidenced by Holshouser.

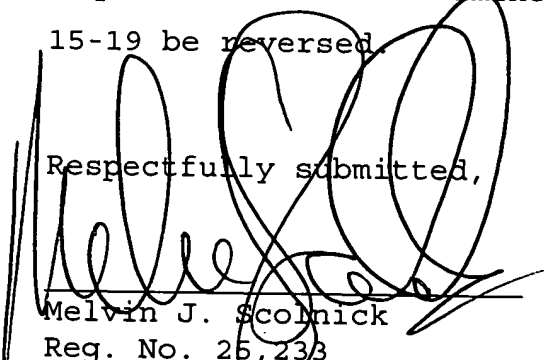
Holshouser teaches an arrangement for attaching a battery to a second part parallel to the keyboard (figs. 6B, item 75; fig. and 9, item 95). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a battery in order to power the telephone."

The Rudisill et al. patent teaches about a telephone with a first housing and a second housing slidably secured to the first housing for movement between an open position and a closed position, said second housing projecting out from said first housing in said open position. The telephone also includes an antenna pivotably attached to said second housing. A position control mechanism is provided to pivot said antenna away from said second housing, and a guide is provided to secure said antenna against pivoting when said second housing is in said closed position. It is respectfully submitted that by employing the same logical reasoning as set forth by appellant above with regard to the rejection of claim 18 under 35 U.S.C. 103(a) over Tsugane et al. in view of Holshouser et al., only one conclusion is possible, i.e., claims 18, 6 and 7 are clearly patentable and not obvious in view of the combined teaching of Rudisill et al. in view of Holshouser et al. There is no other correct legal conclusion!

#### IX. Conclusion

In view of the arguments presented above, it is respectfully requested that the Examiner's rejections of claims 2-7, 13 and 15-19 be reversed.

Respectfully submitted,

  
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## APPENDIX I

### REJECTED CLAIMS

2. A telephone according to claim 18, additionally comprising in the first part a display and a quick-action keyboard, and in the second part a number keyboard.

3. A telephone according to claim 18, additionally comprising in the second part a module which comprises

a circuit board of the number keyboard,

a charging connector to form a connection to an external charging device arranged to charge a battery attached to the second part, and

a connector to form an electric connection between the first and second part.

4. A telephone according to claim 3, wherein said connector for forming the electric connection between the first and second part is simultaneously a connector for creating an electric connection between the second part and a battery attached thereto.

5. A telephone according to claim 3, additionally comprising in said module a vibrating alarm device attached to the circuit board of the number keyboard.

6. A telephone according to claim 18, wherein the second part is slidably movable in relation to the first part in between the first and the second position, for which function the second part comprises slide rails and the first part comprises matching counter-rails.

7. A telephone according to claim 6, wherein said first part and second part are in the first position located essentially on top of each other.

13. A telephone according to claim 18, wherein the second part is rotatably movable with respect to the first part in between the first and the second position, for which function the telephone is provided with a hinge in between the first and the second part.

15. A telephone according to claim 18, additionally comprising a protecting shell of the first part, wherein said antenna is a plane antenna located inside said protecting shell of the first part.

16. A telephone according to claim 18, additionally comprising means for receiving an incoming call by adjusting said first part from the first position to the second position.

17. A telephone according to claim 18, characterised in that it is a mobile phone of a digital cellular network.

18. A telephone comprising a first part; a second part attached to the first part movable between a first position and a second position; a radio transceiver in the first part and an antenna coupled thereto; and in the second part, a keyboard for

providing control input information to the radio transceiver, and an arrangement for attaching a battery to the second part parallel to the keyboard and additionally comprising in the second part a grip design for allowing a user to hold the telephone by the second part.

19. A telephone in accordance with the features of claim 18 wherein said grip by the user is at the area of the lower part of the telephone.

APPENDIX II  
ALLOWABLE CLAIMS

8. A telephone according to claim 6, additionally comprising an elastic member for creating a spring force in between the first and the second part.

9. A telephone according to claim 8, wherein said elastic member is a spring having an excited position and a released position, so that the first position of the second part corresponds to the excited position of the spring, and the second position of the second part corresponds to the released position of the spring.

10. A telephone according to claim 9, additionally comprising a trigger mechanism in order to lock the second part in the position where said spring is excited, and to release the locked second part by means of user action.

11. A telephone according to claim 10, additionally comprising a mechanical attenuator for attenuating the mutual motion between the first and second part while the second part moves in relation to the first part under the influence of the force created by said spring.

12. A telephone according to claim 11, wherein said attenuator comprises a gear wheel and a gear rack arranged in functional interaction with it, said gear wheel and gear rack being located one in the first part of the telephone and the other in the second part thereof, as well as an attenuating member for attenuating the rotating motion of said gear wheel.

**TRANSMITTAL OF APPEAL BRIEF (Large Entity)**

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Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on November 26, 2001

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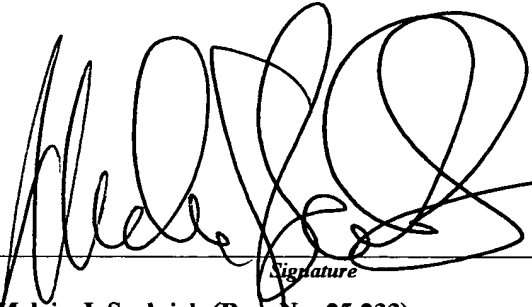
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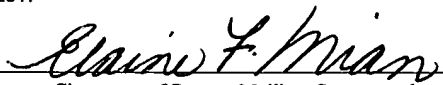
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Dated: 12/20/01

  
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